



BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

No opinion was handed down by the District Court for the District of Columbia. Its findings of fact and conclusions of law appear in the record (pp. 10-12). The opinion of the Court of Appeals for the District of Columbia appears at page 498 of the record and is reported in 138 F. (2nd) 673.

Jurisdiction

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of Feb. 13, 1925, c. 229 (28 U. S. Code, Sec. 347). The decree of the U. S. Court of Appeals for the District of Columbia (R. 499) which petitioner seeks to have reviewed was entered May 1, 1944.

Statement of the Case

The essential facts of the case are stated in the accompanying petition for a writ of certiorari.

Specification of Errors

The errors which petitioner will urge if the writ of certiorari is issued, are that the Court of Appeals for the District of Columbia erred:

1. In holding that the disputed claims were unpatentable over the prior art.

2. In not holding that the disputed claims are patentable to petitioner as supplemental to the interference counts awarded petitioner and are not directed to subject-matter disclosed in the Jenkins application as filed.

Summary of Argument

The points of argument will follow the reasons relied upon for allowance of the writ of certiorari.

ARGUMENT

POINT I

The consideration of the patentability of the disputed claims over the prior art by the U. S. Court of Appeals for the District of Columbia was contrary to the established rule of this Court that issues not presented and considered in the lower court are not subject to review in an appellate court.

The patentability of the disputed claims over the prior art was not put in issue by the pleadings, was not considered by the lower court, and no decision with respect thereto is embraced in its Findings of Fact or Conclusions of Law.

There is no dispute between the parties as to the patentability of the claims over the prior art. That question was raised in the *ex parte* prosecution of the interfering applications before the declaration of the interferences. (See for example the actions of the Primary Examiners, R. 101, 102, 110, 141-5, 171, 210, 213, etc.)

Claims of broader scope than those here in dispute were allowed over the prior art and made the issues of the interferences. The patentability of those broader claims over the prior art was again raised by motion to dissolve the interferences (R. 384, *et seq.*), which motion was denied

(R. 432) and the interferences carried through to final decision on priority of invention with respect to the stated issues, which were awarded in part to petitioner's assignor, Herthel, and in part to his adversary, Jenkins. A patent (No. 2,617,211) was subsequently issued to Jenkins on the application in interference (R. 485).

The Patent Office declares an interference when one of the interfering applications is otherwise ready for allowance—in this case the Jenkins application. The *ex parte* prosecution of the application of petitioner's assignor Herthel was not concluded, at the time the interference was declared, and in accordance with the usual practice, the *ex parte* prosecution was suspended pending the conclusion of the interference proceedings. Upon the resumption of the *ex parte* prosecution of the Herthel application the disputed claims were presented and their allowance urged on the ground that they were specific to procedures disclosed in the Herthel application and not in the Jenkins application. The Patent Office conceded that these claims were more limited than those which had been awarded to Jenkins. The Examiner's statement on appeal asserted:

“(1) Claims 14 and 15 have never previously been before the Board.

(2) Claims 11, 12 and 13,* which the Board passed on in the decision containing the ruling to which applicant adverts, did not contain the limitation here in controversy” (R. 241).

The Patent Office held the subject matter of the disputed claim was disclosed in the Jenkins application and refused the claims on the sole ground that their allowance to Herthel was barred by the interference proceedings and

* Claims 11, 12 and 13 were the claims which were awarded to Jenkins by the Court of Customs and Patent Appeals in the interference controversy. The Patent Office Board of Appeals had awarded priority to Herthel with respect to all controverted subject-matter.

the grant to Jenkins of a patent on the issues awarded to him. *The refusal of the claims on this ground was the sole issue raised by the pleadings and decided by the lower Court.*

An interference, like any other judicial proceeding, is conclusive, not only of the issues presented, but also of those issues which might have been presented—so the question to be decided in this action is whether or not the subject-matter of the disputed claims is disclosed in the Jenkins application as originally filed. This is the question which was decided adversely to petitioner by the lower Court and made the basis for its Findings of Fact and Conclusions of Law. The correctness of that ruling was the sole issue raised by the appeal, and the Appellate Court should have found on that issue and should not have found against petitioner on an issue not presented by the pleadings and with respect to which the parties themselves were not in dispute.

Bradstreet v. Potter, 16 Pet. 317; 41 U. S. 201;
*Old Jordan Mining and Milling Co. v. Société
 Anonyme des Mines*, 164 U. S. 261;
*Gila Valley, Globe & Northern Railway Company
 v. Hall*, 232 U. S. 94;
Duignan v. United States et al., 274 U. S. 195;
Husty v. United States, 282 U. S. 694.

POINT II

There is no public interest involved which justifies the Court of Appeals of the District of Columbia in reviewing on its own motion the patentability of the disputed claims over the prior art in a case of this sort where the issues are defined by the answer of the Commissioner of Patents and no issue of patentability over the prior art is presented.

The Court of Appeals for the District of Columbia doubtless regards *Radtke Patents Corp. v. Coe, et al.*, 122 F.

(2nd) 937 as a precedent for its action here. In that case, however, the Commissioner of Patents was not, as here, the sole respondent. The Commissioner of Patents was in fact merely a nominal respondent. That action, while brought under the provisions of Sec. 4915 R.S.* 35 U. S. C., Sec. 63, was not a case "where a patent on application was refused by the Board of Appeals" wherein the Commissioner of Patents was the sole respondent but was brought by an applicant who was "dissatisfied with the decision of the Board of Interference Examiners" and the other parties to the interference were the real respondents. The only action by the Commissioner of Patents

*§ 63. BILL IN EQUITY TO OBTAIN PATENT

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. R. S. § 4915; February 9, 1893, c. 74, § 9, 27 Stat. 436; March 2, 1927, c. 273, § 11, 44 Stat. 1336; March 2, 1929, c. 488, § 2(b), 45 Stat. 1476; August 5, 1939, c. 451, § 4, 53 Stat. 1212.

in that case seems to have been a motion that the appeal be dismissed as to him.

The question directly at issue in the *Radtke* case was the question of priority among the interferants all of whom were claiming to be the first and original inventors of the invention in dispute. Also in that case a brief was filed by *amicus curiae* asserting that the claims were unpatentable because of new prior art discovered since the original allowance of the disputed claims. This *amicus curiae* was a member of the public directly seeking the protection of the Court in the public interest.

There have been other cases where appellate courts have, in the public interest, ruled on the validity of the patent, where that question was not at issue. For example, *Standard Water Systems Co. et al. v. Griscom Russell Co.*, 278 Fed. 703.

In that case, which was an infringement suit, the defendant was estopped because of certain confidential relations with plaintiff, from contesting the validity of the patent, but the Court of Appeals, acting in the public interest, held the patent invalid, notwithstanding the fact that validity was not in issue because of the estoppel.

Standard Water Systems Co. et al. v. Griscom-Russell Co., 278 Fed. 703, 705:

"It is true that the defendant Row, who asserted invention and received the patent, is estopped from denying invention; but he is not estopped from showing to what extent his alleged invention is limited by the prior art. This question, however, seems to be immaterial in this case. The public is interested in every adjudication with respect to the validity of a patent, and it is the duty of courts having jurisdiction of patent causes to have regard, at all times, of the rights of the public, so that such rights may be rather enlarged than diminished by judicial determination."

In all such cases of which we are aware, there has been evidence before the Court of invalidity of the disputed claims over the prior art, but for some exceptional reason the question of patentability has not been in dispute and consequently, but for the Court's action, there would be, to the detriment of the public, an apparent affirmance of validity without any trial of that issue. In the case at bar the patentability of the disputed claims to the petitioner is the direct issue. The Commissioner of Patents, the party directly charged with the grant or refusal of patents, is the sole party respondent. The Commissioner himself, by his Answer, defined the issues which were tried in the Court below and he did not include lack of patentability over the prior art as one of those issues.

There is nothing exceptional in the case at bar. The circumstances presented are those which arise at the conclusion of practically every Patent Office interference.

At least one of the applications in interference is usually remanded for further *ex parte* prosecution. The applicants naturally and properly endeavor to secure such claims as they can on such unique features of their own processes as are not disclosed by the other party. The Patent Office may not agree with the applicant that the claims relate to the unique features of their own processes, and not to the common subject matter, thereby creating issues such as presented here. In this quite usual situation the patent Examiner can certainly be relied upon to reject the claims if an applicant attempted to claim not only what was awarded his adversary, but also what was not patentable over the prior art.

There is certainly nothing in the record of the case at bar which justifies the Court of Appeals of the District of Columbia in substituting its judgment for the judgment of the officials of the Patent Office on the question of patentability of the disputed claims over the prior art. In fact, it is a well established rule that where, as here, the question of patentability has been raised on motion to dissolve, the presumption of validity is materially strengthened.

This Court, in *Hormel v. Helvering*, 312 U. S. 552 (*supra*, petition, p. 5), points out that it is only in the exceptional case where necessary to prevent miscarriage of justice that an Appellate Court is justified in deciding issues not passed upon below. There is certainly nothing in the case at bar to justify such action.

CONCLUSION

It is urged, therefore, that the petition for writ of certiorari be granted.

Respectfully submitted,

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Dated: New York, N. Y.
July 26, 1944.

